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FACSIMILE TRANSMISSION

DATE: August 4, 2004 **MATTER NUMBER:** 10112540 (LUD 5466.7 DIV)

RECIPIENT(S):	FAX NO.:	PHONE NO.:
Examiner Minh-Tam Davis USPTO - Art Unit 1642	1571 273-0830 and 1703 872-9306	1571 272-0830
SPE Jeffrey SIEW USPTO - Art Unit 1642	1571 273-0787 and 1703 872-9306	1571 272-0787

FROM: Norman Hanson **USER ID:** NH01030 **FLOOR:** 24

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RE: U.S. Serial No. 10/023,182

NUMBER OF PAGES WITH COVER PAGE: 5

Message:

CAUTION - CONFIDENTIAL

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LUD 5466.7 DIV (10112540)

CERTIFICATE OF FACSIMILE TRANSMITTAL

I hereby certify that this correspondence is being transmitted via telecopy pursuant to 37 CFR 1.8 to Group 1642, Examiner Minh Tam DAVIS at fax nos. (571) 273-0830 and (703) 872-9306 and to SPE Jeffrey SIEW at fax nos. (571) 273-0787 and (703) 872-9306 of the Commissioner for Patents on August 4, 2004.

Fani Malikouzakis (Name of Transmitter) Fani Malikouzakis (Signature)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Elisabeth Stockert, et al.

Application No.: 10/023,182 Confirmation No.: 3379

Filed: December 17, 2001 Art Unit: 1642

For: ISOLATED NUCLEIC ACID MOLECULES ENCODING ESO-1 PEPTIDES AND USES THEREOF Examiner: Larry Helms

LETTER - CALL FOR CLARIFICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Office action of July 29, 2004, the Examiner states:

> "Claims 33-35 remain rejected under 35 USC 112, first paragraph, for while being enabled for the full length amino acid sequence encoded by SEQ ID NO: 1, wherein said amino acid sequence is processed by a cell to form a peptide, which complexes to an MHC molecule and is recognized by specific CTLs, but **not enabled for an immunoreactive portion of a protein encoded by SEQ ID NO: 1, wherein said immunoreactive portion is processed by a cell to form a peptide which complexes to an MHC molecule and provides a T cell response**, for reasons already of record in paper of 4/23/04."

Yet, in the first Office Action, page 16, the Examiner states:

> "Claims 32-37, 40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated protein consisting of an immunoreactive portion of a protein encoded by the nucleotide sequence of SEQ ID NO: 1"

Claim 32 specifically recites what the Examiner said was enabled. How, then, can dependent claims be rejected as non-enabled, especially since the language supporting enablement was applied to these claims. Further, how can these two passages be reconciled?

So as to expedite clarification:

(1) a copy of the relevant pages from the Office Action is attached, and

(2) a copy of this communication has been sent to the SPE.

Respectfully submitted,

By _____

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Therefore, it necessarily fails to describe a representative number of such species. In addition, the specification also does not describe structural features common to the members of the genus, which features constitute a substantial portion of the genus.

Thus, the specification does not provide an adequate written description of the hybridizing polynucleotide that is required to practice the claimed invention. Since the specification fails to adequately describe the hybridizing polynucleotides, it also fails to adequately describe the immunoreactive portions of the proteins encoded by said hybridizing polynucleotides.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, SCOPE

1. Claims **32-37, 40** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated protein consisting of an immunoreactive portion of a protein encoded by the nucleotide sequence of SEQ ID NO:1, or the amino acid sequence consisting of SEQ ID NO: 4, 5 or 6, **does not reasonably provide enablement for** an isolated protein consisting of **an immunoreactive portion of the protein encoded by an isolated nucleic acid molecule, the "complementary" sequence of which "hybridizes" to the nucleic acid sequence of SEQ ID NO:1 at 65^0 C or 18 hours, followed by four one hour washes at 2xSSC, 0.1% SDS, and a final wash at 0.2xSSC, wherein said immunoreactive portion of the protein is an amino acid sequence of a tumor rejection antigen**. The specification does not enable any person skilled in the art to

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Accordingly, claims 32-37, 40-41 are examined in the instant application.

The following are the remaining rejections.

DOUBLE PATENTING

The submission of the terminal disclaimers is acknowledged and entered.

It is noted that US 6,525,177 and not US 6,524,177, is the patent involved with double patenting. The Examiner apologizes for any confusion and inconvenience incurred by the inadvertent typographic error.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, SCOPE

1. Claims 33-35 remain rejected under 35 USC 112, first paragraph, for while being enabled for the full length amino acid sequence encoded by SEQ ID NO:1, wherein said amino acid sequence is processed by a cell to form a peptide, which complexes to an MHC molecule and is recognized by specific CTLs, but **not enabled for an immunoreactive portion of a protein encoded by SEQ ID NO:1, wherein said immunoreactive portion is processed by a cell to form a peptide which complexes to an MHC molecule and provides a T cell response**, for reasons already of record in paper of 04/23/04.